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10/594,127	09/25/2006	Akio Sugihara	Q97391	8975
65565	7590	12/10/2009	EXAMINER	
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SUGHRUE-265550  
2100 PENNSYLVANIA AVE. NW  
WASHINGTON DC 20037-3213

In re Application of: :  
Sugihara et al. :  
Serial No.: 10/594,127 : PETITION DECISION  
Filed: September 25, 2006 :  
Attorney Docket No.: Q97391 :

This is in response to the petition filed October 22, 2009 under 37 CFR § 1.181, requesting that the finality of the Office action of August 25, 2009 be withdrawn.

#### BACKGROUND

The examiner mailed an Advisory Action on May 15, 2009. In this Advisory Action, the examiner indicated that the claim amendments filed after final Office action on April 16, 2009 would not be entered because they raised the issue of new matter (see box 3(b) of the Advisory Action form, PTOL-303).

On June 16, 2009, applicants filed a Request for Continued Examination (RCE) along with the appropriate fees. In this RCE, applicants specifically fulfilled the requirements of 37 C.F.R. § 1.114 (submission) and requested that the submission filed on April 16, 2009 be considered for examination.

On August 25, 2009, the examiner mailed a final Office action setting a three month statutory limit for reply.

In response thereto, applicants filed this petition on October 22, 2009 under 37 CFR § 1.181, requesting that the finality of the Office action of August 25, 2009 be withdrawn.

#### DISCUSSION

The petition and the file history have been carefully considered.

In the petition filed on October 22, 2009, applicants argue "it is improper to make the first Action after a RCE final where the Examiner previously refused to enter proposed claim amendments based on the assertion that the proposed amendment presented new matter. See MPEP § 706.07(b). In view of the Examiner's position, applicants filed an RCE and amended the claim language. Although the language in the present claims is slightly different from that in the Amendment filed April 16, 2009, which was not entered by the Examiner allegedly because the proposed amendment raised issues of new matter, the language is similar and the issue is the same."

A review of the prosecution history of this case clearly shows that the examiner refused entry of the amendments filed after final Office action for raising new matter as indicated by the Advisory Action form. It is pointed out that MPEP § 706.07(b) and MPEP § 706.07(h) (VIII) state:

MPEP 706.07(h) (VIII) states:

The action immediately subsequent to the filing of an RCE with a submission and fee under 37 CFR 1.114 may be made final only if the conditions set forth in MPEP 706.07(b) for making a first action final in a continuing application are met...

MPEP 706.07(b), third paragraph states:

However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.

Hence, applicants' points are well-taken and found persuasive. It is decided that the final Office action mailed on August 25, 2009 was, in fact, premature and in error.

## DECISION

The petition is **GRANTED**.

The Office action mailed August 25, 2009 is hereby vacated to the extent that it was made "final" and the Office action is now considered to be a non-final Office action. The amendment submitted November 24, 2009 in response to that action will be entered.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.



Remy Yucel  
Director, Technology Center 1600